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| 10/734,264 | 12/15/2003 | Valerie De La Poterie | 05725.1304-00 | 1471 |
| 22852 7590 03/29/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | EXAMINER VENKAT, JYOTHSNA A | |
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| SHORTENED STATUTORY PERIOD OF RESPONSE | | | MAIL DATE | DELIVERY MODE |
| 31 DAYS | | | 03/29/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/734,264

Applicant(s)

DE LA POTERIE, VALERIE

Examiner

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

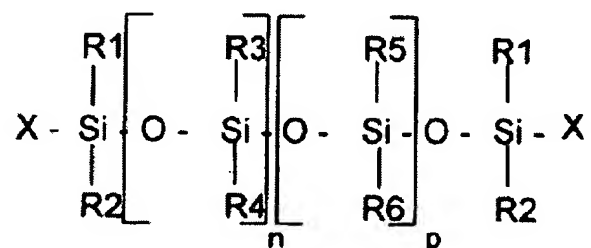
Attachment(s)

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| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 3-6 are, drawn to a composition for coating eyelashes, comprising, in a physiologically acceptable medium: - a dispersing phase comprising an aqueous phase, at least one film-forming polymer in the form of solid particles dispersed in the aqueous phase, and at least one thickener for said aqueous phase in a sufficient amount such that the dispersing phase has a viscosity of greater than or equal to 0.2 Pa.s, and - a fatty phase with a viscosity of greater than or equal to 0.2 Pa.s, dispersed in the aqueous phase, wherein the composition does not comprise a surfactant sufficient to disperse the fatty phase in the dispersing phase, wherein the fatty phase comprises at least one silicone gum corresponding to the formula



classified in class 424, subclass 70.7 and class 514 subclass 1+ depending on the pasty fatty substance.

- II. Claim 7 is, drawn to a composition for coating eyelashes, comprising, in a physiologically acceptable medium: - a dispersing phase comprising an aqueous phase, at least one film-forming polymer in the form of solid particles dispersed in

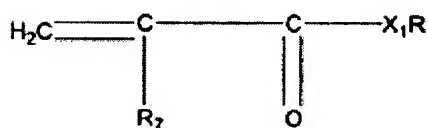
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the aqueous phase, and at least one thickener for said aqueous phase in a sufficient amount such that the dispersing phase has a viscosity of greater than or equal to 0.2 Pa.s, and - a fatty phase with a viscosity of greater than or equal to 0.2 Pa.s, dispersed in the aqueous phase, wherein the composition does not comprise a surfactant sufficient to disperse the fatty phase in the dispersing phase, wherein the fatty phase comprises at least one pasty fatty substances chosen from polydimethylsiloxanes comprising at least one pendent chain chosen from alkyl comprising from 8 to 24 carbon atoms, alkoxy comprising from 8 to 24 carbon atoms, esters of fatty alcohol comprising from 20 to 55 carbon atoms, esters of fatty acid comprising from 20 to 55 carbon atoms, polyvinyl laurate, arachidyl propionate, triisostearyl citrate, cetyl citrate, PVP/eicosene copolymer; lanolins, and derivatives thereof, classified in class 424, subclass 70.7 and class 514 subclass 1+ depending on the pasty fatty substance.

- III. Claim 8 is, drawn to a composition for coating eyelashes, comprising, in a physiologically acceptable medium: - a dispersing phase comprising an aqueous phase, at least one film-forming polymer in the form of solid particles dispersed in the aqueous phase, and at least one thickener for said aqueous phase in a sufficient amount such that the dispersing phase has a viscosity of greater than or equal to 0.2 Pa.s, and - a fatty phase with a viscosity of greater than or equal to 0.2 Pa.s, dispersed in the aqueous phase, wherein the composition does not comprise a surfactant sufficient to disperse the fatty phase in the dispersing phase, wherein the fatty phase comprises at least one semi-crystalline polymer

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copolymers resulting from the polymerization of at least one monomer comprising at least one crystallizable chain chosen from saturated C14 to C24 alkyl (meth)acrylates, C11 to C15 perfluoroalkyl (meth)acrylates, C14 to C24 N-alkyl(meth)acrylamides with or without a fluorine atom, vinyl esters comprising at least one chain chosen from C14 to C24 alkyl and perfluoroalkyl chains, vinyl ethers comprising at least one chain chosen from C14 to C24 alkyl and perfluoroalkyl chains, C14 to C24 alpha-olefins, para-alkylstyrenes comprising at least one alkyl group comprising from 12 to 24 carbon atoms, with at least one monomer chosen from optionally fluorinated C1 to C10 monocarboxylic acid esters and amides of the following formula:



wherein R₇ is chosen from H and OH, R is chosen from optionally fluorinated C1-C10 alkyl groups and X₁ is chosen from O, NH and NR₈ wherein R₈ is chosen from optionally fluorinated C1-C10 alkyl groups classified in class 424, subclass 70.7 and class 514 subclass 1+ depending on the pasty fatty substance.

- IV. Claim 9 is, drawn to a composition for coating eyelashes, comprising, in a physiologically acceptable medium: - a dispersing phase comprising an aqueous phase, at least one film-forming polymer in the form of solid particles dispersed in the aqueous phase, and at least one thickener for said aqueous phase in a sufficient amount such that the dispersing phase has a viscosity of greater than or

equal to 0.2 Pa.s, and - a fatty phase with a viscosity of greater than or equal to 0.2 Pa.s, dispersed in the aqueous phase, wherein the composition does not comprise a surfactant sufficient to disperse the fatty phase in the dispersing phase, wherein the fatty phase comprises at least one at least oils thickened with at least one structuring agent classified in class 424, subclass 70.7 and class 514 subclass 1+ depending on the pasty fatty substance.

- V. Claims 10-14 are, drawn to a composition for coating eyelashes, comprising, in a physiologically acceptable medium: - a dispersing phase comprising an aqueous phase, at least one film-forming polymer in the form of solid particles dispersed in the aqueous phase, and at least one thickener for said aqueous phase in a sufficient amount such that the dispersing phase has a viscosity of greater than or equal to 0.2 Pa.s, and - a fatty phase with a viscosity of greater than or equal to 0.2 Pa.s, dispersed in the aqueous phase, wherein the composition does not comprise a surfactant sufficient to disperse the fatty phase in the dispersing phase, wherein the fatty phase comprises at least one pasty fatty substances chosen from polydimethylsiloxanes comprising at least one pendent chain chosen from alkyl comprising from 8 to 24 carbon atoms, alkoxy comprising from 8 to 24 carbon atoms, esters of fatty alcohol comprising from 20 to 55 carbon atoms, esters of fatty acid comprising from 20 to 55 carbon atoms, polyvinyl laurate, arachidyl propionate, triisostearyl citrate, cetyl citrate, PVP/eicosene copolymer; lanolins, and derivatives thereof, classified in class 424, subclass 70.7 and class 514 subclass 1+ depending on the pasty fatty substance.

- VI. Claims 1, 15-18 and 19-23 are, drawn to a composition for coating eyelashes, comprising, in a physiologically acceptable medium: - a dispersing phase comprising an aqueous phase, at least one film-forming polymer in the form of solid particles dispersed in the aqueous phase, and at least one thickener for said aqueous phase in a sufficient amount such that the dispersing phase has a viscosity of greater than or equal to 0.2 Pa.s, and at least one wax in the form of particles dispersed in the aqueous phase, wherein the composition does not comprise any surfactant sufficient to disperse the at least one wax in the aqueous phase, classified in class 424, subclass 70.7 and class 554 subclass 1+.
- VII. Claims 44-45 are drawn to a non-therapeutic cosmetic care and/or makeup process for a keratin material, comprising applying to the keratin material a composition comprising, in a physiologically acceptable medium: - a dispersing phase comprising an aqueous phase, at least one film-forming polymer in the form of solid particles dispersed in the aqueous phase, and at least one thickener for said aqueous phase in a sufficient amount such that the dispersing phase has a viscosity of greater than or equal to 0.2 Pa.s, and a fatty phase with a viscosity of greater than or equal to 0.2 Pa.s, dispersed in the aqueous phase, wherein the composition does not comprise a surfactant sufficient to disperse the fatty phase in the dispersing phase and the fatty phase can be wax in the form of particles dispersed in the aqueous phase classified in class 424, subclasses 62, 63, 64, 69 and 70.7.

VIII. Claims 46-47 are, drawn to a method for coating keratin fibres, comprising applying to the keratin fibres a cosmetic composition comprising, in a physiologically acceptable medium, a dispersing phase comprising an aqueous phase, at least one film-forming polymer in the form of solid particles dispersed in the aqueous phase, and at least one thickener for said aqueous phase in a sufficient amount such that the dispersing phase has a viscosity of greater than or equal to 0.2 Pa.s, and a fatty phase with a viscosity of greater than or equal to 0.2 Pa.s dispersed in the aqueous phase, wherein - the composition does not comprise a surfactant sufficient to disperse the fatty phase in the dispersing phase, and - the composition is effective for obtaining a smooth and uniform film deposited on the keratin fibres and/or a film having at least one of the following properties: being resistant to at least one of water, tears, and perspiration and having a charging effect on the keratin fibres and the fatty phase can be wax in the form of particles dispersed in the aqueous phase classified in class 424, subclass 70.7.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-VI are directed to related to distinct products. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed do not overlap in scope. The fatty phase claimed in each group are drawn to divergent subject matter. It is an undue search burden to examine all the groups

Inventions I-VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are drawn to different products. The compositions of groups I-VI are useful for coating eyelashes and the compositions of group VII are useful for cosmetic care and makeup process for keratin material and this can be lipsticks, blushes, foundations and nail care and this is different from coating eyelashes.

Although there are no provisions under the section for “Relationship of Inventions” in MPEP § 806.05 for inventive groups that are related to *different methods*, restriction is deemed proper because the methods appear to constitute patentable distinct inventions for the following reasons: Groups VII-VIII encompass methods that are distinct functionally and are not required one for the other. Groups VII-VIII utilize a common product, but comprise substantively different method steps and achieve different goals. Therefore search and examination of all the methods along with the product in one patent application would result in an undue burden, since the search for the three methods are not co-extensive.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the

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inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

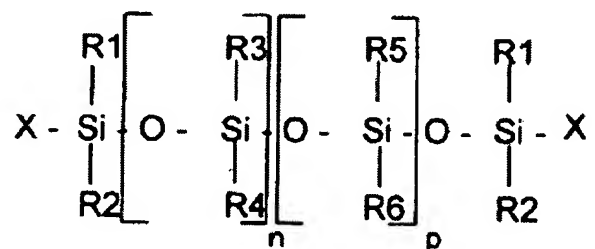
Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

ELECTION OF SPECIES

If applicant's elect any group, they are further required to elect **single disclosed species** belonging to each of the fatty phases. If applicant's elect group I they are further required to elect the species belonging to silicone gum and define the variables X, R1-R6, n and p. There are numerous species belonging to this polymer and it's a search burden to examine all the species. The same is true for each of the fatty phases of groups II-VI.

ELECTION OF SPECIES

This application contains claims directed to the following patentably distinct species: The species are as follows.



The species are independent or distinct because there are different polymers depending on R1-R6. R1-R2 and R5-R6 are alkyl groups, wher as R3-R4 can be alkyl and also aryl radicals. Aryl radical can be simple member like benzene or naphthalene or polycyclic compounds or

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substituted benzene or substituted naphthalene.. X can be alkyl or hydroxyl or vinyl. Thus there are myriad of compounds in the above structure and it is a search burden to examine all the groups.

Applicant is required under 35 U.S.C. 121 to elect a **single disclosed species** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 3 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

ELECTION OF SPECIES

This application contains claims directed to the following patentably distinct species: the species belong to group II. The species are as follows:

7. The composition according to claim 1, wherein the fatty phase comprises at least one pasty fatty substance chosen from polydimethylsiloxanes comprising at least one pendent chain chosen from alkyl comprising from 8 to 24 carbon atoms, alkoxy comprising from 8 to 24 carbon atoms, esters of fatty alcohol comprising from 20 to 55 carbon atoms, esters of fatty acid comprising from 20 to 55 carbon atoms, polyvinyl laurate, arachidyl propionate, triisostearyl citrate, cetyl citrate, PVP/eicosene copolymer; lanolins, and derivatives thereof.

The species are independent or distinct because they are drawn to divergent compounds. It is a search burden to examine all the compounds.

Applicant is required under 35 U.S.C. 121 to elect a **single disclosed species** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 7 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

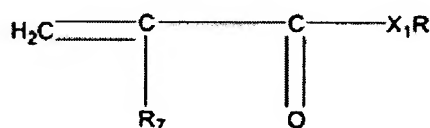
Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

ELECTION OF SPECIES

This application contains claims directed to the following patentably distinct species: the species are as follows:

8. The composition according to claim 1, wherein the fatty phase comprises at least one semi-crystalline polymer chosen from copolymers resulting from the polymerization of at least one monomer comprising at least one crystallizable chain chosen from saturated C₁₄ to C₂₄ alkyl (meth)acrylates, C₁₁ to C₁₅ perfluoroalkyl

(meth)acrylates, C₁₄ to C₂₄ N-alkyl(meth)acrylamides with or without a fluorine atom, vinyl esters comprising at least one chain chosen from C₁₄ to C₂₄ alkyl and perfluoroalkyl chains, vinyl ethers comprising at least one chain chosen from C₁₄ to C₂₄ alkyl and perfluoroalkyl chains, C₁₄ to C₂₄ alpha-olefins, para-alkylstyrenes comprising at least one alkyl group comprising from 12 to 24 carbon atoms, with at least one monomer chosen from optionally fluorinated C₁ to C₁₀ monocarboxylic acid esters and amides of the following formula:



wherein R₇ is chosen from H and CH₃, R is chosen from optionally fluorinated C₁-C₁₀ alkyl groups and X₁ is chosen from O, NH and NR₈ wherein R₈ is chosen from optionally fluorinated C₁-C₁₀ alkyl groups

The species are independent or distinct because they are drawn to divergent compounds and in each category there are numerous species depending on the carbon chain length. It is a search burden to examine all the species.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 8 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

ELECTION OF SPECIES

This application contains claims directed to the following patentably distinct species: the species are volatile oils or non-volatile hydrocarbon based oils or silicone oils or fluoro oils. The species are independent or distinct because they are drawn to divergent compounds. It is a search burden to examine all the species.

Applicant is required under 35 U.S.C. 121 to elect a **single disclosed species** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 9 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

ELECTION OF SPECIES

This application contains claims directed to the following patentably distinct species: the species are oils thickened with lipophilic gelling agents or oils thickened with organogelling agents. The species are independent or distinct because they are drawn to divergent compounds. There are numerous compounds belonging to “ lipophilic gelling agents”. The same is true for “organo gelling agents” . It is a search burden to examine all the species

Applicant is required under 35 U.S.C. 121 to elect a **single disclosed species for** prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 10-11 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

This application contains claims directed to the following patentably distinct species:
belonging to wax. See below for the various waxes claimed.

15. The composition according to claim 1, wherein the fatty phase comprises at least one wax chosen from beeswax, lanolin wax, Chinese insect waxes, candelilla wax, ouricurry wax, cork fibre wax, sugarcane wax, berry wax, Japan wax, sumach wax, montan wax, waxy copolymers and esters thereof, waxes obtained by catalytic hydrogenation of animal or plant oils comprising at least one fatty chain chosen from C₈-C₃₂ linear and branched fatty chains, silicone waxes and fluoro waxes.

16. The composition according to claim 1, wherein the fatty phase comprises at least one wax chosen from waxes with a melting point ranging from 30°C to 70°C.

17. The composition according to claim 1, wherein the fatty phase comprises at least one polar wax.

18. The composition according to claim 1, wherein the fatty phase comprises at least one wax chosen from candelilla wax, beeswax, berry wax, hydrogenated jojoba wax, and olive wax obtained by hydrogenation of olive oil esterified with stearyl alcohol.

The species are independent or distinct because the waxes are drawn to divergent waxes since the source of wax obtained is different. It is a search burden to examine all the groups.

Applicant is required under 35 U.S.C. 121 to elect a **single disclosed species** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 15-19 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is

allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Claims 1-2, 24-43 and 48 link(s) inventions I and II-VI. The restriction requirement between the linked inventions is **subject to** the nonallowance of the linking claim(s), claims 1-2, 24-43 and 48. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

A telephone call was made to Thalia Warnement on 3/21/07 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

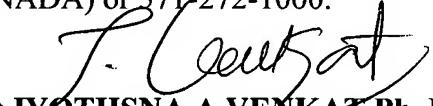
Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JYOTHSNA A VENKAT Ph. D
Primary Examiner
Art Unit 1615
